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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,820	11/25/2003	Bruce N. Ames	18941H-003830US	9373

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EXAMINER	
BETTON, TIMOTHY E	
ART UNIT	**PAPER NUMBER**
1614	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/722,820	AMES, BRUCE N.	
	Examiner	Art Unit	
	Timothy E. Betton	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-58* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-58* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicants' arguments, filed 16 October 2006, have been fully considered but they are not persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant invention.

Remarks

The prior reference Krishna et al. evaluates the effects of changes in the ring structure on antioxidant activity of cyclic nitroxides and their corresponding N-hydroxylamines. Krishna teaches the importance of "stable nitroxides" and their secondary hydroxylamine and amine precursors (see, e.g., Abstract, line 1; page 3477, column 2,line 24; page 3478, column 1, lines 28 and 44; and page 3480, column 2, line 25). Applicants' maintain that Examiner proposes that one of skill would choose to substitute one of the two carbon moieties of the secondary hydroxylamines in Krishna with a hydrogen. However, Applicants' allege that the Examiner's proposed modification does not logically follow from the emphasis in Krishna on the ability of stable cyclic nitroxides to act as antioxidants.

For exemplary purposes, the effectiveness of any given antioxidant in the body depends on which free radical is involved, how and where it is generated, and where the target of damage is. Thus, while in one particular system an antioxidant may protect against free radicals, in other systems it could have no effect at all. Or, in certain circumstances, an antioxidant may even act as a "pro-oxidant" that generates toxic

oxygen species (Parnes, R. B., The Antioxidant Process, printed pages 1-3, especially page 1). One of ordinary skill in the pertinent art would aptly recognize the properties, characteristics, and susceptibilities of free radicals and antioxidants as changeable and mutable. Thus, any proposed modification logically flows from the emphasis in Krishna et al. Said reference teaches that "[s] table nitroxide free radicals have found a wide range of applications in biology and medicine (see page 5537), which would suggest the motivation in the shifting and/or replacement of certain chemical groups on said core hydroxylamine moiety.

Further, Krishna focuses on evaluating the effect of changes in ring structure on antioxidant activity. Applicants' invention is based on the importance of the primary N-hydroxylamine functional group, which does not cyclize. In this instance, the practicing methods of Krishna et al. encompass the embodiment of alleged invention in that to cyclize suggests covering a wider range of particular moieties in order to determine the central issue of therapeutic invention. Thus, there is proper motivation to modify Krishna et al.

One of ordinary skill in the pertinent art would at once recognize the importance of the limitations directed toward Schmidl et al. [T] he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Since carnitine and nitroxide compounds are shown to have advantageous properties to an individual, the skilled artisan would be motivated to combine them together for administration.

Claim Rejections –35 USC§ 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Joint Inventors

This application currently names joint inventors.

In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishna et al. in view of Schmidl et al. of U.S. Patent No. 5,504,072. Krishna et al. teach of the protective effects of inter alia hydroxylamines. Krishna et al. teach that cellular damage may result from the cytotoxicity of reactive oxygen species, (see column 1, page 3477). Krishna et al. also teach that the reactive oxygen species are byproducts of normal processes in aerobic environments, and when there are

imbalances in these reactive oxygen species oxidative stress results to cells, (see page 3477). Krishna et al. also disclose that hydroxylamines have been shown to protect mammalian cells exposed to reactive oxygen species, such as super oxide, hydrogen peroxide, organic hydroperoxides, and redox cycling and anticancer agents, (see column 2, page 3478). In addition, Krishna et al. teach of screening methods to test the effectiveness of hydroxylamines to provide protection to mammalian cells that are exposed to a reactive oxygen species, namely hydrogen peroxide. The results were performed with an in vitro assay, (see column 2, page 3478). In the assay model of this teaching the efficacy of the antioxidant, such as hydroxylamine, was evaluated by exposing the cells to a reactive oxygen species, namely hydrogen peroxide, and assessing the viability of the cells both in the absence and in the presence of a fixed concentration of the test compound, (see column 2, page 3480). The assessment would compare the amounts of the reactive oxygen species present, while the instant invention is comparing the amounts of the antioxidant of the hydroxylamine present after contact with the cells. There are many ways to measure the concentration of an assay, such as a decrease in the concentration of the unwanted species or compound, (as in Krishna et al.) or still by measuring the concentration of the antioxidant compound of the hydroxylamine (as is obviously claimed by applicant).

The instant claims differ only in screening methods for primary hydroxylamines whereas the prior art reference of Krishna et al. are directed to screening methods with the utilization of secondary amines. The skilled artisan would most certainly been motivated from the screening methods of Krishna et al. to employ other antioxidant or

cytoprotective hydroxylamine compounds to protect cells from the deleterious effects due to oxidative damage due to inter alia, reactive oxygen species. The generation of reactive oxygen species, as taught by Krishna et al., is evident in many various biochemical and aerobic environments. Accordingly, if a cellular event such as from a variety of scenarios, for instance ischemia or inflammation or cancer or cytokines or still other events, which can generate and cause oxidative damage to a cell, would be obviously protected with the presence of hydroxylamine compounds, as clearly taught by Krishna et al. Clearly, it would have been obvious to the skilled artisan to utilize other hydroxylamine compounds and derivatives, which would obviously include primary hydroxylamine compounds and their derivatives, because the reaction between the oxidative damage lies between the reactive oxygen species and they hydroxylamine moiety. The skilled artisan would additionally be motivated to use primary hydroxylamine compounds and their derivatives especially since the hydroxylamine moiety of a primary hydroxyl amine is less sterically hindered than a primary hydroxylamine compound. In addition, one having ordinary skill in the art would have been motivated to use primary N-hydroxylamines to offset the deleterious effects of reactive oxygen species to cells when the prior art specifically teaches that secondary N-hydroxylamines also perform this very same function. For this reason, the skilled artisan would expect that compounds with primary N-hydroxylamines would also reduce the effects of reactive oxygen species to cells because the only structural difference lies with the presence of absence of a hydrogen atom attached to the functional group of the N-hydroxylamine moiety. Moreover, the skilled artisan would even expect that the

structurally related compounds of primary N-hydroxylamines would react more readily than the secondary N-hydroxylamines due to the absence of a secondary carbon-containing moiety, thus decreasing the steric hindrance of the secondary N-hydroxylamine. The amount and level of skill involved with substituting "bulky" groups, such as alkyl moieties for less "bulky" groups, such as a hydrogen atom, is well within the level of the skilled artisan. In fact, the replacement of an alkyl group for a hydrogen atom is expected and obvious, rather than as purported by applicants as unexpected and nonobvious because of the difference in steric hindrance between a primary N-hydroxylamine and a secondary N-hydroxylamine. Furthermore, one having ordinary skill in the art would have been motivated to use closely related N-hydroxylamine-containing compounds and their derivatives, which clearly embraces primary N-hydroxyl amines due to the fact that the reaction between the unwanted reactive oxygen species, is with the N-hydroxylamine-containing moiety.

Schmidl et al. teach of the pharmaceutical administration of vitamins, minerals, carbohydrates, proteins, and amino acids, and namely carnitine. Schmidl et al. teach that carnitine is to be included in nutritional compositions because it possess advantageous properties to an individual, namely improved energy metabolism, (see column 7, lines 1-21 and Table 8). "It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose .... [T] he idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA

1980). Since carnitine and nitroxide compounds are shown to have advantageous properties to an individual, the skilled artisan would be motivated to combine them together for administration.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy E. Betton whose telephone number is (571) 272-9922. The examiner can normally be reached on Monday-Friday 8:30a - 5:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ardin H Marschel 5/29/07

ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER

TEB